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1
2 RECORD OF ORAL HEARING
3 UNITED STATES PATENT AND TRADEMARK OFFICE

4
5 BEFORE THE BOARD OF PATENT APPEALS
6 AND INTERFERENCES
7

8
9 *Ex parte* GILLES RUBINSTENN, DANIELA GIACCHETTI,
10 and FRANCIS PRUCHE
11

12
13 Appeal 2010-009210
14 Application 10/024,496
15 Technology Center 3600
16

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18 Oral Hearing Held: September 14, 2010
19

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21 Before HUBERT C. LORIN, JEAN R. HOMERE and
22 BIBHU R. MOHANTY, Administrative Patent Judges.
23

24 ON BEHALF OF THE APPELLANT:
25

26 KENIE HO, ESQ.
27 Finnegan, Henderson,
28 Farabow, Garrett & Dunner, LLP
29 901 New York Avenue, N.W.
30 Washington, D.C. 20001

1 The above-entitled matter came on for hearing on Tuesday,
2 September 14, 2010, commencing at 2:30 p.m., at the U.S. Patent and
3 Trademark Office, 600 Dulany Street, 9th Floor, Alexandria, Virginia,
4 before Jon Hundley, Notary Public.

5 JUDGE LORIN: Okay, counsel, would you introduce yourself,
6 please?

7 MR. HO: My name's Kenie Ho. That's spelled K-e-n-i-e H-o.

8 JUDGE LORIN: Thank you very much.

9 We've reviewed and are familiar with the record in your case.
10 You have 20 minutes. You may proceed.

11 MR. HO: Thank you, Your Honor.

12 Your Honor, I'm primarily here today to answer any specific
13 questions you might have regarding the application. But if you don't, I have
14 prepared some statements regarding the application.

15 So before I jump into that, if you have a specific question, I'd be
16 glad to answer it. Otherwise, I'll just jump right into my prepared.

17 JUDGE LORIN: Yes, please do. Please jump in.

18 MR. HO: Okay.

19 I'm going to start with the high-level description of the claimed
20 invention, and the primary reference cited by the Examiner. And then I'll
21 move onto the claim and specifically the 102 rejection, and compare how the
22 primary reference is distinguishable, based on certain claim elements in the
23 claims.

24 And then I'll move on to the 103 rejections.

1 Now the general idea of the claimed invention is that you have
2 a beauty advisory system. What that is, is it's a device that may access local
3 weather information from a database or from a website on the Internet, such
4 as weather.com, and combine that accessed information with the personal
5 information of a user.

6 And through that information, those two pieces of information,
7 it can generate a recommendation for use of a product, based on the access
8 information and personal information.

9 So for example, you might have a device in the bathroom. And
10 in the morning the device might go out to the Internet, access the local
11 weather information, and then combine that with your own personal
12 information, such as your skin type, your age, your ethnicity, to then
13 generate a specific recommendation for use of a product.

14 Now in contrast, the primary reference that the Examiner has
15 applied against the claims is the Maloney reference. What the Maloney
16 reference teaches is a company sends a test kit to a user.

17 That test kit allows the user to test the water hardness and the
18 water pH level in the user's home. And from that, the company can
19 customize a specific product, so that -- like shampoo or soap -- so that it
20 works well with the user's specific water hardness and pH level.

21 So that's the general background of the beauty advisory system
22 and the primary reference.

23 I'm going to move onto the specific rejection, the 102 rejection,
24 first.

1 Now the Examiner rejects Independent Claim 25, which is the
2 only 102 rejection -- well, Claim 25 and 26, 26 depending from Claim 25.
3 He rejects it, based on Maloney.

4 And there are numerous features recited in Claim 25, but the
5 specific claim elements that I want to focus on today are: One, accessing
6 local information for a geographic area location of a subject; and two,
7 generating by computer system at least one recommendation for use of at
8 least one cosmetic product, the recommendation being a function of personal
9 information of the subject and the local information.

10 Now with respect to the first claim element, the accessing
11 element, Maloney fails to teach that. As I described earlier, Maloney just
12 teaches or discloses testing, using a test kit, water hardness and pH level.

13 That is not accessing local information for a geographic area
14 location of a subject. Basically accessing is not testing. When I --

15 JUDGE MOHANTY: The information would be accessed,
16 once it's in the profile database? The water hardness would be the local
17 information, and then when you accessed it was when you were actually
18 accessing the database to get the profile data.

19 MR. HO: Maloney doesn't teach that. Maloney teaches you
20 testing the water hardness, and just testing the pH level. There's no teaching
21 of -- the only thing it teaches is that once you take that testing and to
22 customize a product. There's no accessing through --

23 JUDGE MOHANTY: Well, when you get the results, whatever
24 that is, for the water hardnesses, aren't you accessing that data?

1 MR. HO: If Maloney specifically taught that the data is
2 somewhere stored in a specific database or is on line and then --

3 JUDGE MOHANTY: Well, all you have to do is access that
4 information. So if the water -- you're using that water test information here
5 to create this profiling data, correct?

6 MR. HO: In Maloney, actually the profiling data is separate
7 data. It's other data. It's like they use some things like the users maybe sent
8 preference of the product, or the user's particular -- the packaging they
9 would like the product to be in.

10 JUDGE MOHANTY: Okay. But you're still using that data.
11 So you're still accessing it somehow. Right? Because you're going to use
12 that water level -- I mean, that water hardness or as a pH.

13 It's not like you just take the water test information and just
14 throw it out the window. You're going to use it again, so you're going to
15 access it.

16 MR. HO: I see your point. And --

17 JUDGE MOHANTY: Okay. Well, move on. That's fine.

18 MR. HO: Now the other limitation that I pointed out, that I
19 wanted to focus on, was the generating limitation.

20 As I said earlier, Maloney discloses customizing a product.
21 Customizing a product is not generating a specific recommendation for use.

22 For example, when we refer to generating a recommendation
23 for use, that would be something like the, hmm, the device in your bathroom
24 saying, "We recommend you apply this cream twice today, because the UV

1 level index is X, and the temperature is Y, and the humidity is Z, and
2 therefore, because of that, the usage of the product would best be this way."

3 Maloney teaches customizing a product. What that would mean
4 is just you're modifying a formula, based on the water level hardness or the
5 water pH level.

6 And that does not teach --

7 JUDGE MOHANTY: Now Maloney teaches that -- page 16,
8 lines 2 through 6 -- a list of recommended product choices, which
9 correspond to an updated consumer profile, is then provided to the
10 consumer.

11 So he specifically says "recommended product choices." So
12 how is that not generating at least one recommendation?

13 MR. HO: Well, that's not a recommendation for use. See, that's
14 a series of products that the user may select, and then have customized,
15 based on the tested water hardness, or the water pH level.

16 But that does not, as the claim says, generate a recommendation
17 for use, where --

18 JUDGE MOHANTY: Well, if I'm giving you a list of
19 recommended product choices, I mean, isn't that for use? I mean, I don't -- if
20 I'm saying this is a recommended product choice, isn't that something I want
21 you to use?

22 I mean --

23 MR. HO: That's -- sure, the person who's selling the product is
24 recommending that you buy our product and you use our product. But that's
25 not a recommendation on how to use the product.

1 Generating a recommendation for use -- our position is that it's
2 not providing just a list of products and customizing a product.

3 JUDGE HOMERE: But it also says that the recommendation is
4 based on the user profile. What do you have to say about that?

5 MR. HO: It's not based on -- well, we disagree about this -- but
6 it's not based on the accessed local information.

7 Because it's only at most based on a profile and water hardness.
8 And the way the water hardness and the water pH is obtained is through a
9 test measuring kit.

10 And our position is testing is not equal to accessing.

11 JUDGE MOHANTY: Okay. Point taken. You can move on.

12 MR. HO: Moving on to the 103 rejection, Claim I, the
13 Examiner rejects Claim 1 under Section 103, based on a combination of
14 Maloney and a Fox reference.

15 JUDGE MOHANTY: Mm-hmm.

16 MR. HO: The features that I want to focus on today are -- there
17 are two claim elements: Number one, determining local information, based
18 on demographic information reflecting a geographic area location of the
19 subject; and number two, generating by a computer system, at least one
20 recommendation for use of at least one cosmetic product, based on personal
21 information and a local information that was determined from the
22 demographic information.

23 Now the Examiner concedes that Maloney does not teach
24 determining local information based on demographic information, and relies
25 on the Fox reference to cure that deficiency.

1 However, what Fox teaches is, it teaches analyzing the effect of
2 weather on the sales of a product at a particular location for a particular time.

3 So for example, it looks at how the weather has effected the
4 past sales of a particular product like umbrellas at a department store in
5 Hoboken, New Jersey, during the fall season.

6 Well, that does not disclose determining local information
7 based on demographic information. Well, the combination does not disclose
8 it. First there is no motivation to combine the Maloney reference and the
9 Fox reference.

10 Now you have the Fox reference, talking about looking at
11 collecting weather information, based on demographics data; and you have
12 the Maloney reference, which does not refer to using weather forecast
13 information in customizing a product.

14 Therefore, it does not make sense, there is no suggestion to use
15 the collected weather information from Fox, that's based on demographic
16 information, in combination with Maloney, to customize a product.

17 Now even if there was motivation to combine, the logical
18 outcome of the combination would be customizing a product, based on water
19 hardness and pH level, as disclosed in Maloney, followed by analysis of the
20 product's sales, based on the weather forecast, as disclosed in Fox.

21 So that itself wouldn't teach --

22 JUDGE MOHANTY: It's not so much the water pH; it's your
23 claiming whatever it is local information --

24 MR. HO: Mm-hmm --

1 JUDGE MOHANTY: Which is from the Maloney reference.
2 But this Fox reference here talks about the impact of weather on retail
3 planning applications in their abstract. They talk about the personal care and
4 consumer products, which is related to Maloney.

5 And then they specifically talk about demographics at column
6 9.

7 So I mean, and the elements are there. You can argue the
8 combination. But I see the elements as being there, in terms of weather
9 impact, demographic data, consumer product.

10 He talks about here, the impact of weather on retail planning
11 applications as not being limited to the -- including personal care products, I
12 assume, and consumer products; outdoor events. So.

13 MR. HO: I understand your point.

14 JUDGE MOHANTY: Okay.

15 MR. HO: And what my point is, is that the weather
16 information -- well, my point is that Maloney doesn't refer to the weather
17 information at all, when it comes to customizing a product. And the
18 teaching in Fox, when it comes to using demographic information to
19 determine local information, is specifically for weather forecasts.

20 So there's no connect between the two, based on that.

21 JUDGE MOHANTY: Yeah. Okay. I see your point.

22 MR. HO: Now moving on to the rejection of Claim 32 under
23 Section 103, based on Maloney and Fox, the features that I want to focus on,
24 or the claim elements I want to focus on in Claim 32, are:

1 One, obtaining by a computer system local information about a
2 geographic area, the local information at least including a weather forecast
3 for the geographic area;

4 And two, generating a plurality of different cosmetic product
5 usage recommendations, each recommendation being a function of the local
6 information, including the weather forecast for the geographic area.

7 So I think you can see what my argument here is, again. But
8 the claim language is a little bit different. But the same argument that I've
9 made so far I'm making for this particular claim, with respect to Maloney
10 and Fox.

11 The next claim I would like to move onto is Claim 41, which
12 the Examiner rejected under Section 103, based on Maloney and Fox again.

13 And the claim elements I'm focusing on here are very similar to
14 what I've been talking to so far, and it's in the brief. So I won't re-state it
15 here.

16 That's pretty much all I had as far as a prepared statement. If
17 Your Honors have any specific questions, I'd be glad to answer.

18 JUDGE LORIN: All right. Thank you, counsel.

19 Any questions?

20 (Discussion was held off the record.)

21 JUDGE LORIN: No, counsel, we have no further questions.

22 Thank you very much.

23 MR. HO: Thank you very much.

24 Whereupon, at 2:46 p.m. the proceedings were concluded.